

## PATENT COOPERATION TREATY

From the  
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

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## **FILE COPY 416**

### NOTIFICATION OF TRANSMITTAL OF INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Rule 71.1)

Form PCT/IPEA/416(July 1992) DO NOT MAIL

		Date of Mailing (day/month/year)
Applicant's or agent's file reference  47418P/B588		<b>IMPORTANT NOTIFICATION</b>
International application No.  PCT/US01/48577	International filing date (day/month/year)  30 OCTOBER 2001	Priority Date (day/month/year)  31 OCTOBER 2000
Applicant  BIOCATALYTICS, INC.		

1. The applicant is hereby notified that this International Preliminary Examining Authority transmits herewith the international preliminary examination report and its annexes, if any, established on the international application.
2. A copy of the report and its annexes, if any, is being transmitted to the International Bureau for communication to all the elected Offices.
3. Where required by any of the elected Offices, the International Bureau will prepare an English translation of the report (but not of any annexes) and will transmit such translation to those Offices.

#### 4. REMINDER

The applicant must enter the national phase before each elected Office by performing certain acts (filing translations and paying national fees) within 30 months from the priority date (or later in some Offices)(Article 39(1))(see also the reminder sent by the International Bureau with Form PCT/IB/301).

Where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary examination report. It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned.

For further details on the applicable time limits and requirements of the elected Offices, see Volume II of the PCT Applicant's Guide.

**PATENT COOPERATION TREATY**  
**FILE COPY 409**

**INTERNATIONAL PRELIMINARY EXAMINATION REPORT**  
**(PCT Article 36 and Rule 70)**

Form PCT/IPEA/409 (cover sheet) (July 1998) FILE COPY - DO NOT MAIL

Applicant's or agent's file reference  47418P/B583	<b>FOR FURTHER ACTION</b>	See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No.  PCT/US01/48577	International filing date (day/month/year)  30 OCTOBER 2001	Priority date (day/month/year)  31 OCTOBER 2000	
International Patent Classification (IPC) or national classification and IPC IPC(7): C12P 13/04, 13/06, 13/22; C12Q 1/32, 1/52 and US Cl.: 435/4, 26, 16, 108, 116			
Applicant BIOCATALYTICS, INC.			

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.
2. This REPORT consists of a total of \_\_\_\_\_ sheets.
 

This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority. (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

These annexes consist of a total of \_\_\_\_\_ sheets.

3. This report contains indications relating to the following items:

- I  Basis of the report
- II  Priority
- III  Non-establishment of report with regard to novelty, inventive step or industrial applicability
- IV  Lack of unity of invention
- V  Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI  Certain documents cited
- VII  Certain defects in the international application
- VIII  Certain observations on the international application

Date of submission of the demand  31 MAY 2002	Date of completion of this report  19 DECEMBER 2002
Facsimile No.	Authorized officer AND Telephone No.  RALPH CUTOMER (703) 908-1235

INTERNATIONAL PRELIMINARY EXAMINATION REPORT  
 Form PCT/IPEA/409 (Box I) (July 1998)  
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International application No.

PCT/US01/48577

I. Basis of the report

1. With regard to the elements of the international application:\*

the international application as originally filed

the description:

pages \_\_\_\_\_ 1-23 \_\_\_\_\_, as originally filed

pages \_\_\_\_\_ NONE \_\_\_\_\_, filed with the demand

pages \_\_\_\_\_ NONE \_\_\_\_\_, filed with the letter of \_\_\_\_\_

the claims:

pages \_\_\_\_\_ 24-27 \_\_\_\_\_, as originally filed

pages \_\_\_\_\_ NONE \_\_\_\_\_, as amended (together with any statement) under Article 19

pages \_\_\_\_\_ NONE \_\_\_\_\_, filed with the demand

pages \_\_\_\_\_ NONE \_\_\_\_\_, filed with the letter of \_\_\_\_\_

the drawing:

pages \_\_\_\_\_ NONE \_\_\_\_\_, as originally filed

pages \_\_\_\_\_ NONE \_\_\_\_\_, filed with the demand

pages \_\_\_\_\_ NONE \_\_\_\_\_, filed with the letter of \_\_\_\_\_

the sequence listing part of the description:

pages \_\_\_\_\_ NONE \_\_\_\_\_, as originally filed

pages \_\_\_\_\_ NONE \_\_\_\_\_, filed with the demand

pages \_\_\_\_\_ NONE \_\_\_\_\_, filed with the letter of \_\_\_\_\_

2. With regard to the language, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language \_\_\_\_\_ which is:

the language of a translation furnished for the purposes of international search (under Rule 23.1(b)).

the language of publication of the international application (under Rule 48.3(b)).

the language of the translation furnished for the purposes of international preliminary examination (under Rules 55.2 and/or 55.3).

3. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

contained in the international application in printed form.

filed together with the international application in computer readable form.

furnished subsequently to this Authority in written form.

furnished subsequently to this Authority in computer readable form.

The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.

The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4.  The amendments have resulted in the cancellation of:

the description, pages \_\_\_\_\_ NONE

the claims, Nos. \_\_\_\_\_ NONE

the drawings, sheets/fig \_\_\_\_\_ NONE

5.  This report has been drawn as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).\*\*

\* Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17).

\*\* Referred to under item 1 and annexed to this report.

**INTERNATIONAL PRELIMINARY EXAMINATION REPORT**Form PCT/IPEA/409 (Box II) (July 1998)  
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International application No.

PCT/US01/48577

**II. Priority**

1.  This report has been established as if no priority had been claimed due to the failure to furnish within the prescribed time limit the requested:
  - copy of the earlier application whose priority has been claimed.
  - translation of the earlier application whose priority has been claimed
2.  This report has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid

Thus for the purposes of this report, the international filing date indicated above is considered to be the relevant date.

**3. Additional observations, if necessary:**

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

Form PCT/IPEA/409 (Box III) (July 1998)  
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International application No.  
PCT/US01/48577

III. Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

1. The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non obvious), or to be industrially applicable have not been and will not be examined in respect of:

the entire international application.

claims Nos. \_

because:

the said international application, or the said claim Nos. \_ relate to the following subject matter which does not require international preliminary examination (*specify*).

the description, claims or drawings (*indicate particular elements below*) or said claims Nos. \_ are so unclear that no meaningful opinion could be formed (*specify*).

the claims, or said claims Nos. \_ are so inadequately supported by the description that no meaningful opinion could be formed.

no international search report has been established for said claims Nos. \_.

2. A meaningful international preliminary examination cannot be carried out due to the failure of the nucleotide and/or amino acid sequence listing to comply with the standard provided for in Annex C of the Administrative Instructions:

the written form has not been furnished or does not comply with the standard.

the computer readable form has not been furnished or does not comply with the standard.

**INTERNATIONAL PRELIMINARY EXAMINATION REPORT**Form PCT/IPEA/409 (Box IV) (July 1998)  
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International application No.

PCT/US01/48577

**IV. Lack of unity of invention**

1. In response to the invitation to restrict or pay additional fees the applicant has:

- restricted the claims.
- paid additional fees.
- paid additional fees under protest.
- neither restricted nor paid additional fees.

2.  This Authority found that the requirement of unity of invention is not complied with and chose, according to Rule 68.1, not to invite the applicant to restrict or pay additional fees

3. This Authority considers that the requirement of unity of invention in accordance with Rules 13.1, 13.2 and 13.3 is

- complied with.
- not complied with for the following reasons:

4. Consequently, the following parts of the international application were the subject of international preliminary examination in establishing this report

- all parts.

**INTERNATIONAL PRELIMINARY EXAMINATION REPORT**Form PCT/IPEA/409 (Box V) (July 1998)  
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International application No.

PCT/US01/48577

**V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement****1. statement**

Novelty (N)	Claims <u>none</u>	YES
	Claims <u>1-30</u>	NO
Inventive Step (IS)	Claims <u>none</u>	YES
	Claims <u>1-30</u>	NO
Industrial Applicability (IA)	Claims <u>1-30</u>	YES
	Claims <u>none</u>	NO

**2. citations and explanations (Rule 70.7)**

Claims 1-30 lack novelty under PCT Article 33(2) as being anticipated by each of Voelskow, Wood, Then, Stoyan.

Voelskow (4,745,059) teaches in column 1 lines 33-57, preparing phenylalanine from an acid.

Wood (4,710,467) teaches in columns 2, 3 and 8, preparing phenylalanine from an acid.

Then (5,753,470) teaches in columns 1, 2 and 9, preparing amino acids by transamination.

Stoyan (5,854,035) teaches in column 3, synthesis of amino acids by reductive amination of the corresponding keto acids.

Each of the features of the claims are taught by the above references for the same function as claimed.

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 NEW CITATIONS

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NONE